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In re Application of :
Eric J. Jansen et al. :
Application No. 09/589,973 : DECISION ON RENEWED
Filed: June 8, 2000 : PETITION PURSUANT TO
Attorney Docket No.: 71189-1300 : 37 C.F.R. § 1.181(A)
Title: EXTRACTION CLEANING WITH :
OXIDIZING AGENT :
:

This is a decision on the submission of October 23, 2008, entitled "reply to decision on petition." This submission is being treated as a renewed petition pursuant to 37 C.F.R. § 1.181(a), requesting that the period for providing a reply to the notice of panel decision from pre-appeal brief review be reset.

This renewed petition pursuant to 37 C.F.R. § 1.181(a) is **GRANTED-IN-PART**.

BACKGROUND

On April 4, 2008, a Pre-Appeal Brief Request for Review was filed along with a Notice of Appeal. On May 13, 2008, a Notice of Panel Decision from Pre-Appeal Brief Review (notice) was mailed, indicating that the application remained under appeal. The notice indicated that a response was due by June 13, 2008, and that extensions of time were available. No response was received, and no extension of time was requested. As such, this application went abandoned on June 14, 2008.

RELEVANT PORTIONS OF THE C.F.R. AND MPEP

37 C.F.R. § 1.134 sets forth, *in toto*:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

- (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
- (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
- (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Section 711.03(c)(I)(A) of the MPEP sets forth, *in toto*:

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney

docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and **that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received.** A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 2d 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

(Emphases added).

PROCEDURAL HISTORY AND ANALYSIS

An original petition pursuant to 37 C.F.R. § 1.181(a) was filed on August 4, 2008, where Petitioner asserted that the notice was not received at the correspondence address of record,¹ described the system used for recording an Office action received at the

¹ Original petition, page 2.

correspondence address of record with the USPTO,² and established that the docketing system is sufficiently reliable.³

The original petition was dismissed via the mailing of a decision on September 2, 2008, for Petitioner did not:

- provide a statement, establishing that a search of Petitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received;
- provide a copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required, and;
- either provide a copy of the master docket, or set forth that no such master docket exists.

With this renewed petition, Petitioner has provided a statement, establishing that a search of the "electronic file jacket...and the application contents"⁴ indicates that the Office action was not received.

Petitioner has further provided a copy of the record where the non-received Office action would have been entered had it been received is required, in the form of the individual docket record that is associated with this particular application.^{5, 6} It is noted in passing that the docket that is associated with this application contains an entry entitled "APPEAL BRIEF" that has a "BASE" date of May 13, 2008, which is the date on which the relevant notice was mailed. Ms. Judge has indicated that this entry was entered after the notice was downloaded from PAIR on July 28, 2008.⁷ As such, the recording of this document in the docket that is associated with this application does not evince receipt of the document.

² Judge declaration of facts submitted with the original petition, paragraphs 2-3.

³ Id.

⁴ Renewed petition, page 2.

⁵ See Exhibit B, as referenced in the renewed petition, page 2. See also Judge declaration of facts submitted with this renewed petition, paragraph 4.

⁶ It is noted that on the third page of this renewed petition, Petitioner has described Exhibit B as a list of all incoming mail that was received from May 1, 2008 through July 28, 2008. However, this assertion is erroneous, and appears to be a typographical error.

⁷ Judge declaration of facts submitted with this renewed petition, paragraph 5.

Finally, Petitioner has indicated that a master docket does not exist,⁸ and has provided a mail log of all mail received from May 1, 2008 through July 28, 2008.⁹

Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that the notice of May 13, 2008 was not received.

CONCLUSION

When filing the original petition, Petitioner included an Appeal Brief, the fee that is associated with the filing of the same, and a two-month extension of time so as to make timely this submission. Due to the fact that a response to the notice has been submitted, **the notice will not be reissued, and the period for response will not be restarted**, as requested on the third page of this renewed petition.¹⁰

However, since it has been established that the notice was not received, **the Appeal Brief and the associated fee will be considered timely filed, and the two-month extension of time will be refunded to Petitioner's Deposit Account**, in due course.

The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of this decision, so that the Appeal Brief that was filed on August 13, 2008 can receive further processing in due course.

Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.¹¹ All other inquiries concerning examination procedures should be directed to the Technology Center.



Anthony Knight
Supervisor
Office of Petitions

⁸ Renewed petition, pages 2-3. See also Judge declaration of facts submitted with this renewed petition, paragraph 7.

⁹ See Exhibit A, as referenced in the Judge declaration of facts submitted with this renewed petition, paragraph 3(a).

¹⁰ See also the first pages of the original and the renewed petitions.

¹¹ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any of Petitioner's further action(s).